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In re Application of
WANG *et al*
U.S. Application No.: 10/581,845
PCT No.: PCT/CA04/02082
Int. Filing Date: 06 December 2004
Priority Date: 04 December 2003
Attorney Docket No.: HMI P1191US1
For: SYSTEM AND METHOD PROVIDING
ENHANCED FEATURES FOR
STREAMING VIDEO-ON-DEMAND

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 30 April 2008.

BACKGROUND

On 03 October 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 30 April 2008, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration signed by two of five named inventors; a statement of Cecelia Lu; exhibits 1 - 4; a copy of a petition and decision in U.S. Application No. 10/727,857; and the required fees.

DISCUSSION

Applicants claim that three of the five named inventors, Meng Wang, Jian Wang and Ying Luo, cannot be located after a diligent effort and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 03 October 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Items (2) and (4) are not yet satisfied.

The petition fee of \$200.00 has been paid. The last known addresses of Meng Wang, Jian Wang and Ying Luo were provided in the petition. Items (1) and (3) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), applicants' burden in showing that an inventor cannot be reached is explained in section 409.03(d)(I) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions . . .

In this case, petitioners have submitted a declaration by Cecelia Lu who states that she attempted to contact Meng Wang by courier at his last known address, and Jian Wang and Ying Lao by registered mail. Ying Lao was also tried to be reached by email. None of these attempts were successful. Petitioners also provided documentary evidence as required.

The 37 CFR 1.47(a) applicants also explained that the present application claims priority to U.S. Application No. 10/727,857 which had a 37 CFR 1.47 petition granted with regards to two of the nonsigning inventors, Meng Wang and Jian Wang. A copy of this petition and decision were provided.

This is not sufficient to meet the requirements of section 409.03(d)(I) of the MPEP.

With regards to Meng Wang and Jian Wang, petitioners included a copy of a prior petition in which extensive efforts to reach each of the two inventors was deemed unsuccessful. However, these efforts ended over four years ago, in February 2004. It is also noted that the last known addresses of each inventor listed in U.S. Application No. 10/727,857 are different than the addresses given for Meng Wang and Jian Wang in the subject petition. Petitioners have not explained how this occurred. Petitioners must attempt to locate Meng Wang and Jian Wang again.

In addition, there is no evidence that petitioners conducted any search for Ying Luo. Petitioners did attempt to contact Mr. Luo by email, but did not explain how they obtained this email address and why they expected to receive a response. Petitioners must provide a more detailed statement of facts in their renewed petition.

Petitioners must conduct a new search for each of the inventors. Petitioners must also provide a statement of facts by a person having firsthand knowledge, that fully describes the exact facts which are relied on to establish that a diligent effort to locate each inventor was made. Petitioners must also provide copies of documentary evidence to corroborate the facts listed, such as cover letters, internet searches and postal receipts.

For these reasons, item (2) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by two of the five named co-inventors on behalf of themselves and the nonsigning joint inventor.

However, it appears that petitioners submitted one complete declaration and a portion of another declaration. The declaration submitted is a 3-page declaration consisting of 4 pages (two page 3's). While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration, it is not clear what inventive entity was listed on the declaration signed by each co-inventor.

For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT

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Legal Administration.



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